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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Hiroomi KUWAHARA (Deceased)

Docket No.: KAS.074

Serial No.: 10/573,483

Art Unit: 3752

Filed: March 24, 2006

Examiner: Ryan Alexander Reis

For: SPRAY GUN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Sir:

This is an appeal pursuant to 35 U.S.C. 134 from the Examiner's decision rejecting claims 4-6 as set forth in the final Office Action dated February 25, 2009.

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I. Real party in interest.

The real party in interest is the Assignee of record, KAKO ZOKI CO., LTD., having a place of business at 279-1, Kou, Tacibana, Mukaishima-cho, Mistuki-gun, Hiroshima 722-0071, Japan.

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II. Related appeals and interferences.

None.

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III. Status of claims.

Claims 4-6 stand finally rejected by the Examiner and are the subject of the appeal.

Claims 1-3 were cancelled.

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IV. Status of amendments.

An Amendment Under 37 CFR 1.116 was filed on March 23, 2009, after the final rejection. The Examiner has indicated that the Amendment would be entered for purposes of appeal.

V. Summary of claimed subject matter.

There is one independent claim, claim 4. Claim 4 is drawn to a spray gun having a paint jetting part for jetting pressure paint in atomized state and air jetting means for forming a covering air flow surrounding the periphery of atomized paint jetted from the paint jetting part (page 1, line 29 – page 2, line 9 of the original specification; Figs. 1-3), whereby the pressure paint is atomized by friction to air outside the paint jetting part (page 8, lines 17-20), comprising:

a body frame (page 4, lines 1-2; Figs. 1-3) having a length, a front end, a rear end, and an air intake (page 6, lines 4-8; Figs. 1-3) adjacent to the rear end for receiving compressed air (page 7, lines 26-28);

an air ventilation path (page 4, lines 18-20; Fig. 3) for flowing the compressed air from the air intake to the air jetting means;

an air valve (page 5, lines 26-27; Fig. 3) adjacent to the rear end for opening and closing the air ventilation path, the air jetting means being mounted at the front end of the body frame and having a ring-shaped nozzle having nozzle holes arranged at a fixed pitch in the circumferential direction of the ring-shaped nozzle (page 5, lines 10-15; Figs. 1-4), the nozzle holes receiving air from the air ventilation path and guiding the air to rotate around the center of the ring-shaped nozzle;

the paint jetting part including a paint valve (page 4, lines 24-25; Fig. 3) mounted at the center of the ring-shaped nozzle, the paint valve extending forwardly from the front end of the body frame to a paint outlet (page 4, lines 24-29; Figs. 1-3) that is positioned forward of the nozzle holes of the ring-shaped nozzle of the air jetting means (page 3, lines 28-30; page 4, lines 24-25; page 5, lines 10-15; Figs. 1-3);

a lever operating member (page 4, lines 1-4; Figs. 1-3) mounted between the front end and the rear end of the body frame for human operation; and

an interlocking means (page 2, lines 17-28; page 8, lines 1-17; page 9, lines 16-18; Figs. 1-3) responsive to operation of the lever operating member for opening and closing both the air valve and the paint valve.

Claim 5 depends on claim 4 and recites a bar prehension part (page 3, lines 23-26; Fig. 1) extending along and rearward of the lever operating member and having a hollow cylindrical member and a connecting member to be connected to a paint feeding hose (page 7, lines 14-19; Fig. 1), whereby the pressure paint from the feeding hose passes through the hollow cylindrical member and reaches the paint valve, the bar prehension part adapted to be grasped together with the lever operating member.

Claim 6 depends on claim 5 and recites an air intake for the air ventilation path, the air intake being positioned rearward of the bar prehension part (page 5, line 26 – page 6, line 7; Figs. 1-3).

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VI. Ground of rejection to be reviewed on appeal.

The ground of rejection for review is the rejection of claims 4-6 under 35 U.S.C. 103(a) as being unpatentable over the Govindan reference (US 3,857,511).

VII. Argument

Independent claim 4

In the rejection, the Examiner states that the Govindan reference discloses all of the subject matter of claim 4, except the paint outlet being positioned forward of the nozzle holes of the ring-shaped nozzle. The Examiner also states that it would have been an obvious matter of design choice to have made the paint outlet of Govindan forward of the nozzle holes of the air-jetting means, because the appellant has not disclosed that such a structure provides an advantage, is used for a particular purpose, or solves a stated problem.

The feature of claim 4 of a paint outlet that is positioned forward of the nozzle holes of the ring-shaped nozzle of the air jetting means does have an advantage. Positioning the paint outlet forward of the nozzle holes of the ring-shaped nozzle results in 1) the paint not adhering on the body frame and 2) the nozzle holes (25a) not clogging. These advantages are suggested in lines 13-15 on page 2 of the application, but advantages need not be described in the application, as was made clear by *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995). In *In re Chu*, Judge Rich said: "We have found no cases supporting the position that a patent applicant's evidence and/or arguments traversing a Section 103 rejection must be contained within the specification." In addition to finding that advantages need not be described in the application, he held that placement of a catalyst within a bag retainer, as opposed to another position, would not have been merely a matter of "design choice." Judge Rich added that there was no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify a first structure to place the catalyst within a bag retainer as opposed to between two filter bags as disclosed in a Szymanski reference. The appellant points out that in the present case, as in *In re Chu*, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the

art to modify a first structure (Govindan) to place the paint outlet 3 forward of the nozzle holes of the ring-shaped nozzle as opposed to placing the paint outlet 3 of Govindan in the position disclosed by Govindan. Furthermore, in *In re Gal* 25 USPQ2d 1076 (Fed. Cir. 1992), which is cited in *In re Chu*, the court said that a finding of obvious design choice is precluded where the claimed structure and the function it performs are different from the prior art. The structure of claim 4 described above, the paint outlet being positioned forward of the nozzle holes of the ring-shaped nozzle, and the function it performs, causing the paint not to adhere on the body frame and the nozzle holes (25a) not to clog, are different from the structure and function of Govindan. Accordingly, a finding of obvious design choice should be precluded here as well.

Dependent claim 5

In rejecting claim 5, which depends on claim 4, the Examiner states that it would have been obvious to have connected the paint feeding hose through the handle of the housing 2 of Govindan, because the appellant has not disclosed that such an arrangement provides an advantage, is used for a particular purpose, or solves a stated problem. The appellant points out that, in fact, providing the bar prehension part with a connecting member to be connected to a paint feeding hose, as in claim 5 of the present application, provides an advantage over the arrangement disclosed in Govindan. The advantage is that providing the bar prehension part with the connecting member for connecting the paint feeding hose enables the spray gun of the present invention to be held and aimed with less strength or force. Arranging the paint feeding hose 7 of Govindan forward of the handle of the housing exerts a strong force on the front of the spray gun of Govindan. More specifically, the weight of the paint feeding hose 7 of Govindan acts at a moment arm with respect to the place where the operator holds the spray gun, that is, the weight of the paint feeding hose 7 acts with a torque around the handle of the Govindan device.

This torque must be counteracted by the operator in order to hold and aim the device in the desired direction. Thus, greater force or strength must be exerted by a user on the handle of Govindan in order to 1) overcome the force on the front of the spray gun applied by the forward-positioned hose and also to 2) maintain the gun in a desired aimed orientation. By nature, a spray gun for paint needs to be aimed with some accuracy. With respect to this feature of claim 5 of a bar prehension part having a connecting member to be connected to a paint feeding hose, as in *In re Chu*, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify a first structure (Govindan) to connect the paint feeding hose 7 of Govindan through the handle of the device as opposed to connecting the paint feeding hose of Govindan in the position disclosed by Govindan, which is forward of the handle.

Dependent claim 6

In rejecting claim 6, the Examiner contends that the Govindan reference discloses that its air intake is positioned rearward of the prehensile part, as is recited in claim 6. However, the appellant points out that the air intake 1 of Govindan is received in the prehensile part of the housing 2 (Fig. 1), and is not positioned rearward of the prehensile part, as is required by claim 6.

The Govindan reference does not disclose the feature of claim 6 of a bar prehension part extending along and rearward of the lever operating member and an air intake for a air ventilation path, the air intake being positioned rearward of the bar prehension part. During a personal interview with the appellant's attorney, the Examiner indicated that his reason for his determination is that "rearward" does not appear to be defined in the claim. However, the appellant points out that claim 6 depends on claim 5, which depends on claim 4, and that claim 4 defines "rear" by reciting, for example, a body frame having a length, a front end, a rear end,

an air intake adjacent to the rear end, an air valve adjacent to the rear end, air jetting means mounted at the front end of the body frame, and a paint valve extending forwardly from the front end of the body frame to a paint outlet that is positioned forward of the nozzle holes of the ring-shaped nozzle. Thus, it would be clear to one of ordinary skill what is meant be “rearwardly” in claim 6, and it is clear that the air intake 1 of Govindan is not positioned rearward of the prehensile part, as is required by claim 6.

Furthermore, it would not have been obvious to position the air intake of Govindan rearward of the bar prehension part of Govindan. As a result of the feature of claim 6 of the air intake being positioned rearward of the bar prehension part, the bar prehension part can have the connecting member that is to be connected to a paint feeding hose, as is recited in claim 5, because the bar prehension part is not occupied by the air intake, as it is in the Govindan reference. Thus, the arrangement of claim 6 improves the operability of the spray gun. With respect to this feature of claim 6, as in *In re Chu*, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify a first structure (Govindan) to position the air intake 1 rearward of the prehensile part, as is required by claim 6, rather than positioning the air intake 1 in the position disclosed by Govindan, which is in the handle.


VIII. CONCLUSION

For the foregoing reasons, the Examiner's rejections of claims 4-6 should not be sustained. A decision to that effect is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0562.

Respectfully submitted,

Date: 8-24-09


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents

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John P. Shannon

VIII. Claims appendix.

4. A spray gun having a paint jetting part for jetting pressure paint in atomized state and air jetting means for forming a covering air flow surrounding the periphery of atomized paint jetted from the paint jetting part, whereby the pressure paint is atomized by friction to air outside the paint jetting part, comprising:

a body frame having a length, a front end, a rear end, and an air intake adjacent to the rear end for receiving compressed air;

an air ventilation path for flowing the compressed air from the air intake to the air jetting means;

an air valve adjacent to the rear end for opening and closing the air ventilation path, the air jetting means being mounted at the front end of the body frame and having a ring-shaped nozzle having nozzle holes arranged at a fixed pitch in the circumferential direction of the ring-shaped nozzle, the nozzle holes receiving air from the air ventilation path and guiding the air to rotate around the center of the ring-shaped nozzle;

the paint jetting part including a paint valve mounted at the center of the ring-shaped nozzle, the paint valve extending forwardly from the front end of the body frame to a paint outlet that is positioned forward of the nozzle holes of the ring-shaped nozzle of the air jetting means;

a lever operating member mounted between the front end and the rear end of the body frame for human operation; and

an interlocking means responsive to operation of the lever operating member for opening and closing both the air valve and the paint valve.

5. A spray gun as claimed in claim 4, further comprising:

a bar prehension part extending along and rearward of the lever operating member and having a hollow cylindrical member and a connecting member to be connected to a paint feeding hose, whereby the pressure paint from the feeding hose passes through the hollow cylindrical member and reaches the paint valve, the bar prehension part adapted to be grasped together with the lever operating member.

6. A spray gun as claimed in claim 5, further comprising:

an air intake for the air ventilation path, the air intake being positioned rearward of the bar prehension part.

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IX. Evidence appendix.

None.

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X. Related proceedings appendix.

None.